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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q58469

Jacques JOLLY, et al.

Appln. No.: 09/532,968

Group Art Unit: 1731

Confirmation No.: 8709

Examiner: John M. Hoffmann

Filed: March 22, 2000

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For: A METHOD OF MANUFACTURING AN OPTICAL FIBER PREFORM AND MORE
PARTICULARLY A PREFORM OF LARGE DIAMETER

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief (in triplicate) to address points raised by the Examiner's Answer of September 23, 2002. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

The Examiner's Answer raises issues regarding Appellants' "Summary of the Invention" (Section V.) and "Arguments" (Section VIII.) set forth in the Appeal Brief. Appellants address the issues raised by the Examiner separately for each section below.

V. Summary Of the Invention

The Examiner takes the position that Appellants' Summary of the Invention "is deficient because (1) it fails to summarize what steps are actually required by the independent claim" and

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"it fails to completely summarize the 'one-ended reduction in length'." Examiner's Answer at page 2. The Examiner's basis for asserting this position lacks foundation.

In particular, the Examiner asserts that the "claims make no mention of any number of layers in the final product." Id. First, Appellants' claims are method claims directed to building up an optical fiber preform. A consequence of carrying out the method steps recited in the claims is the formation of a number of layers of silica being deposited on the optical fiber preform. Claim 1, in particular, recites that the preform is to be manufactured in "successive passes corresponding to the preform and the torch being displaced relative to each other, certain ones of the passes carried out with material being supplied . . . so that each successive pass leads to a new layer of material being deposited on the preform when material is supplied . . ." Claim 1, therefore, recites steps that necessarily result in the formation of multiple layers of silica to build up the preform.

The Examiner also states that the "claims are comprising in nature and thus are open to having an equal number of layers deposited - for instance by another torch - or by the same torch in a subsequent step." Id. As noted above, claim 1 requires the deposition of layers by "successive passes corresponding to the preform and the torch being displaced relative to each other" It is of no consequence to the construction of the claims and the issue considered in this appeal that, hypothetically, an additional torch may be used to add other layers. The Examiner's statement is simply not relevant.

The Examiner further notes: "the statement that the preform has 'a reduced diameter portion' is also not required by the independent claim. Although that is a disclosed feature, it

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simply is not required by the claim." Id. The Examiner then sets forth the holding in In re Van Geuns that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Id. While the Examiner does not misstate the holding in In re Van Geuns, this holding does not support the Examiner's position. The method steps of claim 1 necessarily result in a reduced diameter portion. Appellants refer the Board to pages 3-4 of their Appeal Brief, which underscore that the claimed method steps necessarily result in a reduced diameter portion.

Finally, the Examiner incorrectly asserts that Appellants' reference to page 8, lines 3-10 of their Specification does not describe the recited "one-ended reduction in length." In an attempt to support this allegation, the Examiner points to Fig. 3, which he contends shows that "when torch 5 cuts the layers, there is a reduction in length of the layers." Examiner's Answer at page 3. The Board should not be misled by the Examiner's incorrect characterizations. Figure 3 is described at page 10, lines 4-12 of Appellants' specification as illustrating the cleaving of the preform, not the one-ended reduction in length of an intermediate layer of deposited silica interposed during deposition of successive layers of silica as required by claim 1. On the other hand, Appellants' specification at page 8, lines 3-10, explicitly defines the one-ended reduction of length with respect to Fig. 2 (not Fig. 3), "as a corresponding reduction in relative displacement between the torch and the preform," and set to a value "L1" as shown in Fig. 2. There is simply no rational basis for the Examiner to rely on Fig. 3 for his construction of this feature.

VIII. Arguments

Turning to Appellants' arguments, the issue on appeal is whether Appellants had possession of the claimed invention as recited in claim 1, which was amended to add the language: "wherein the one ended reduction in the length is greater than a reduction in length of an immediate prior layer from a second to the immediate prior layer."

The Examiner's grounds of rejection as set forth in his Answer are convoluted and, therefore, very difficult to comprehend. However, it appears the crux of the Examiner's position is that, for there to be a reduction in the length of a layer, the layer must first be formed, and only afterwards can it be reduced in length. The Examiner believes that this construction is required by the plain meaning of the expression "one-ended reduction in length." Accordingly, the Examiner argues that the above-quoted language added to claim 1 by amendment finds no support in Appellants' application as filed. The Examiner further argues that, to the contrary, based on the disclosure in Fig. 3, the drawings suggest something opposite to that of the added claim language. See Examiner's Answer at page 4.

The Examiner's reliance on Fig. 3 to construe claim 1 is clearly misplaced for the reasons already discussed above. Namely, when properly construed in light of Appellants' specification, one skilled in the art would certainly understand that the one-ended reduction in length is represented in Fig. 2 by "L1", and not in Fig. 3, which illustrates a cleaving step.

The Examiner states:

It is further argued that after the diameter D1 is achieved,
there is a one-ended reduction in layer length, followed by the

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addition of successive layers. This is incorrect. Such is neither claimed or disclosed. All of the layers are applied first (ostensibly while all of the layer's lengths are kept constant) - and then following that, the lengths of the layers are reduced. See figure 2 which shows all of the layers deposited - figure 3 shows the subsequent reduction in length.

Examiner's Answer at page 5 (emphasis added). The Examiner's construction of claim 1, and his attempt to read Fig. 3 into this claim, is refuted by the clear language of this claim, the specification (especially at page 8), and the figures. Claim 1 requires "interposing a one ended-reduction in the length of at least one layer during a pass and starting from one new layer that is an intermediate layer . . ." There is absolutely no basis for the Examiner to argue that "[a]ll of the layers are applied first" prior to performing the one-ended reduction in length. To the contrary, the one-ended reduction in length is performed for an intermediate layer to create a reduced diameter portion. Then, after the last layer is deposited, the built-up preform is cleaved at the reduced diameter portion as shown in Fig. 3.

The Examiner further argues:

It is completely unreasonable to interpret a "reduction" as something that really is not a reduction. If such were acceptable practice, then inventors would be free to state that "up" really means "down", that "black" means "white", and "cold" means "hot". And when in those rare instances where contradictory

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terminology is proper - the specification must clearly set out what the definition is to be. The present application does not have any such definitions. One of ordinary skill would interpret a "reduction in length of at least one layer" as the layer having a length, and reducing that length - to a value which is less than its prior value (e.g. from 20 cm to 15 cm).

Examiner's Answer at page 7.

The above quote demonstrates the Examiner's continued refusal to properly construe the claims in light of the Appellants' disclosure. Indeed, the Examiner's construction of the language added to claim 1 by amendment is inconsistent with the rest of the claim language, let alone Appellants' disclosure as a whole.

First, the Examiner's position that Appellant's construction of the claim language at issue is comparable to construing terms to mean their exact opposite cannot be taken seriously. The plain and ordinary meaning of the term "reduction" is the state of being reduced (i.e., lessened in size, number, or amount). See, e.g., The Random House College Dictionary, revise edition, 1984. This is what is required under Appellants' construction of claim 1. Overlapping layers of silica are deposited in succession by relatively moving the torch and the preform "in a manner such that the respective lengths of the layers, which lengths are determined by the relative displacements between the torch and the preform, are progressively shortened," with the exception that at least one intermediate layer is interposed having a one-ended reduction in length that is greater than the immediately prior reduction (i.e., shortened or lessened by a greater

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amount). So, the length of each successive pass is reduced, with at least one pass corresponding to an intermediate layer being reduced by a greater amount to form the one-ended reduction in length of that intermediate layer. This construction is entirely consistent with the claim language's plain and ordinary meaning.

Moreover, it is a well-established axiom in patent law that a patentee is free to be his own lexicographer, and, thus, the patentee may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings. For this reason, an analysis of the specification is important to proper claim construction. See, e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (in banc), aff'd, 517 U.S. 370, 38 USPQ 1461 (1996). Therefore, even if, assuming for the sake of argument alone, Appellants' definition were not entirely consistent with the language's plain and ordinary meaning (and Appellants maintain that it is), Appellant's specification at page 8, lines 3 et seq., provides an explicit definition of the language in question. It bears repeating here, with reference to Fig. 2, the specification states:

A one-ended reduction in layer length is imposed by a corresponding reduction in the relative displacement between the torch and the preform. This one-ended reduction is performed during an overlapping pass during which the preform 1' being overlaid is overlaid with a layer of material. The reduction is, for example, set to a value L1 lying in the range 10 millimeters to 200 millimeters. . . .

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The deposition of the concentric layers is then continued on the preform [1'] starting from the layer whose length has been reduced at one end

(emphasis added).

The Examiner goes on to state:

Even if one were to accept the argument that making a length less long than a previous layer is a "reduction" in length of the layer, Applicant's reduction occurs at both ends - it is clearly not "one ended." One of ordinary-skill upon reading the "one-ended" is immediately notified that such is the shortening showing in figure 3. The position that the shortening on two sides is actually a "one-sided reduction" is unsustainable.

Examiner's Answer at pages 8-9.

Here again, the Examiner takes pains to construe the claim language in a manner inconsistent with the claims as a whole and Appellants' disclosure. Claim 1 clearly recites the progressive shortening at both of the preforms such that "a portion of each of the end-pieces decreases uniformly" That is, as shown in Fig. 2, the right and left ends of the preform can have conical shape. The interposed one-ended reduction in length, on the other hand, is a deviation from this uniform reduction that creates a reduced diameter portion near one end, as shown in Fig. 2. There is no reason why one skilled in the art would take away from the claim language, even without reading Appellants' disclosure, the meaning given to it by the Examiner.

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Finally, the Examiner's position regarding claim 3 only underscores that the Examiner's claim construction is awkward and inconsistent with the Appellants' disclosure. Claim 3 merely limits the diameter size at which the one-ended reduction in length is interposed.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellants' Brief on Appeal, Appellants respectfully request that the Board reverse the Examiner's rejection of all claims on Appeal. An early and favorable decision on the merits of this Appeal is requested.

Applicants are submitting herewith a Request For Oral Hearing.

Respectfully submitted,



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